

Notice of Allowability

Application No.

10/673,121

Examiner

Jennifer Kim

Applicant(s)

BHAGWAT ET AL.

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to August 24, 2006 & 11/30/2006.
2. ☒ The allowed claim(s) is/are 78, 80-82 (1, 2-4).
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____ |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date <u>8/24/2006</u> | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

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DETAILED ACTION

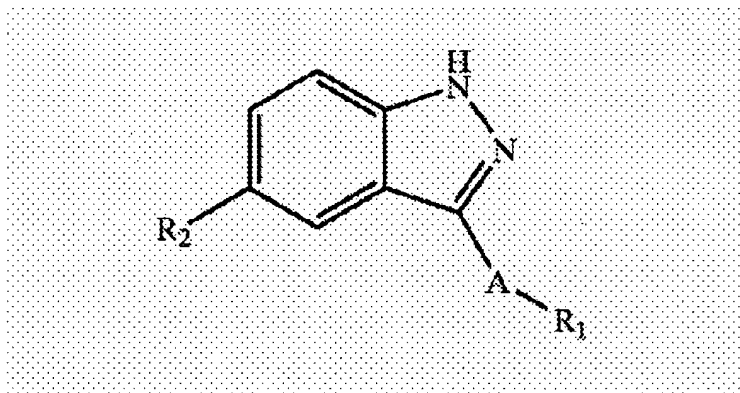
An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Mr. Michael Bruner on November 30, 2006.

The application has been amended as follows:

Claim 78 has been **replaced** with

"A method for treating cancer of the blood, brain, lung or prostate by inhibiting JNK pathway comprising administering to a patient in need thereof an effective amount of a compound having the structure:



or a pharmaceutically acceptable salt thereof, wherein:

A-R₁ is phenyl, optionally substituted with one to four substituents

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independently selected from halogen, alkoxy, $-\text{NR}_8\text{C}(=\text{O})\text{R}_9$,
 $-\text{C}(=\text{O})\text{NR}_8\text{R}_9$, and $-\text{O}(\text{CH}_2)_b\text{NR}_8\text{R}_9$;

R_2 is 3-triazolyl or 5-tetrazolyl;

b is 2 or 3;

R_8 and R_9 are the same or different and at each occurrence independently hydrogen, alkyl, aryl, arylalkyl, heterocycle, or heterocyclealkyl, or R_8 and R_9 taken together with the atom or atoms to which they are bonded form a heterocycle, wherein each of R_8 , R_9 , and R_8 and R_9 taken together to form a heterocycle are optionally substituted with one to four substituents independently selected from R_3 ;

R_3 is at each occurrence independently halogen, hydroxy, carboxy, alkyl, alkoxy, haloalkyl, acyloxy, thioalkyl, sulfinylalkyl, sulfonylalkyl, hydroxyalkyl, aryl, substituted aryl, arylalkyl, substituted arylalkyl, heterocycle, substituted heterocycle, heterocyclealkyl, or substituted heterocyclealkyl."

Reasons for allowance

The following is an examiner's statement of reasons for allowance:

1. The changes to radical R_3 made by Examiner's amendment are editorial in nature.

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2. To improve clarity of the claims the specific pathway has been included.
3. The changes made by Examiner's amendment are not made to avoid any rejections based upon prior art.
4. The claims are allowable over the cited prior art because the prior art does not teach, disclose nor make obvious the claimed method for inhibiting the JNK pathway comprising administering to a patient in need thereof an effective amount of a compound having the structure set forth in claim 78, wherein the administration treats cancer of the blood, brain, lung or prostate.
5. The claimed method of inhibiting the JNK pathway thereby treating cancer of the blood, brain, lung or prostate by administration of the compound having structure set forth in claim 78 is novel because instant compounds to be utilized are claimed in Applicant's parent patent 6,897,231. (see the claims).
6. Applicants overcome the rejection under 35 U.S.C. 112, first paragraph for lacking enablement, by Applicant's persuasive argument and submission of references showing the nexus between inhibition of the JNK pathway and the claimed **specific** cancer.
7. Pursuant to MPEP 804, since the only remaining rejection is the obvious type double patenting (ODP) rejection, the instant ODP rejection is withdrawn over 10/718,185.
8. Any comments considered necessary by applicants must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably

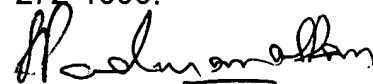
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accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Kim whose telephone number is 571-272-0628. The examiner can normally be reached on Monday through Friday 6:30 am to 3 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Sreenivasan Padmanabhan
Supervisory Primary Examiner
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